



PAC  
JFW

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Hedrick et al.

Application No.: 10/817,625

Filed: April 1, 2004

Title: GAMING MACHINE HAVING  
SECONDARY DISPLAY FOR PROVIDING  
VIDEO CONTENT

Attorney Docket No.:

IGT1P006C1R1/P-161 A CON R1

Examiner: Benjamin Layno

Group: 3711

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first-class mail on May 2, 2007 in an envelope addressed to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

Signed: \_\_\_\_\_

*Chereyce Brown*  
Chereyce Brown

**RENEWED PETITION FOR SUSPENSION OF RULES  
(37 C.F.R. § 1.183)**

Mail Stop Petitions  
Commissioner for Patents  
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Alexandria, VA 22313-1450

Attention: Alesia M. Brown,  
Petitions Attorney,  
Office of Petitions

05/07/2007 MGBREM1 00000033 10817625

01 FC:1462  
02 FC:1253

400.00 OP  
1020.00 OP

Dear Sir:

Applicant requests the Commissioner to suspend or waive the rules in regards to obtaining the signature of one of the inventors for a supplemental declaration in this reissue case and allow prosecution to continue in this application. A brief summary of the current state of the application and reasons in regards to why a suspension of rules is appropriate in this matter is provided as follows.

**Case Status/Justification for Suspension of Rules under 37 C.F.R. § 1.183**

The application herein is a reissue application. To initiate the reissue a declaration was signed by all of the named inventors. After some prosecution, the Examiner indicated that subject matter in the case is deemed allowable. To allow the case to proceed to issuance, Applicant attempted to obtain a supplemental declaration as requested by the Examiner in the Office Communication dated May 26, 2006 in accordance with MPEP section 1414.01. The

supplemental declaration as described in MPEP section 1414.01 requires each inventor to sign a declaration that states,

*1. Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oath(s) and/or declaration(s) submitted in this application, arose without any deceptive intention on the part of the applicant.*

*We hereby declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.*

Applicant was able to obtain a signed declaration from each of the inventors listed on the application except Robert Luciano.

Mr. Luciano is a former employee of the assignee of the application IGT. In the past, Mr. Luciano has always been very cooperative in assisting IGT in prosecution matters in regards to applications that he worked on while employed at IGT including signing the initial reissue declaration filed in this application. Currently, Mr. Luciano is the Chief Technology Office for Bally Gaming and Systems. Bally Gaming and Systems is a direct competitor of assignee in this matter IGT. Mr. Luciano joined the company (Bally Gaming and Systems) in March 2004 just prior to the filing of this application. A brief biography of Mr. Luciano may be found on the Bally web-site <http://ballytech.com/systems/product2.cfm?id=15>. The biography includes a description of his current employment at Bally Gaming and Systems and his previous work with IGT.

At the time the Applicant first sought to seek a signature on supplemental declaration from Mr. Luciano as well as at the current time, the assignee, IGT, and Bally Gaming and Systems are engaged in a number of law suits where IGT is alleging that products manufactured by Bally Gaming and Systems are infringing patents owned by IGT. One example of the litigation proceedings is fashioned as,

**Plaintiff: IGT**

**Defendants: Alliance Gaming Corp., Bally Gaming International, Inc., and Bally Gaming, Inc., d/b/a Bally Gaming and Systems**

**This case is pending in the District of Nevada.**

**The case number is CV-S-04-1676-RCJ-(RJJ).**

**This case is currently Active.**

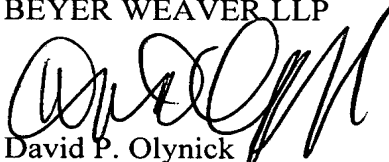
It has been difficult for the Applicant to obtain a signature from Mr. Luciano on the supplemental declaration in this matter. After a number of attempts, Applicant filed a petition under 37 C.F.R. § 1.47(a) with documentary evidence. The petition was denied in an office communication from Office of Petitions dated December 15, 2006. In the response, the Petition Attorney Alesia Brown indicated that a petition under 37 C.F.R. § 1.183 should have been filed since Mr. Luciano had already filed a reissue declaration. Further, the response indicated that the Applicant had not met standard needed to allow a suspension of rules under 37 C.F.R. § 1.183. In particular, the Petition Attorney indicated applicant should have sent a copy of the file histories in this matter as requested by Mr. Luciano.

Applicant sent copies of the file history to Mr. Luciano and has received a response from Mr. Luciano attached as Exhibit G to this correspondence. An updated declaration of facts is also attached. The updated declaration of facts includes reference to Exhibits F and G, which are also attached herein. Exhibits A-E, which are referenced in the updated declaration of facts and which were filed with the previous petition, are not attached because they have not been modified.

It is clear in Mr. Luciano's response (Exhibit G) dated April 4, 2007 that Mr. Luciano does not intend to sign the supplemental declaration. Further, Applicant believes that Mr. Luciano in his current position as CTO of a company in direct competition with Applicant and involved in active litigations alleging patent infringement including Applicant has a clear conflict of interest in this matter. Thus, for at least these reasons, Applicant requests that a suspension of rules be granted under 37 C.F.R. § 1.183 and prosecution in this case be allowed to proceed without obtaining Mr. Luciano's signature on a supplemental reissue declaration.

Enclosed is our Check No. 13517 in the amount of \$1,420.00 for payment of the Petition Fee and three month(s) extension fees for a Large Entity in accordance with 37 CFR § 1.17(f). However, if it is determined that any fees are due, the Commissioner is hereby authorized to charge such fees to Deposit Account 500388 (Order No. IGT1P006C1R1).

Respectfully submitted,  
BEYER WEAVER LLP



David P. Olynick  
Reg. No. 48,615

P.O. Box 70250  
Oakland, CA 94612-0250  
(510) 663-1100

## Exhibit F

From: Origin ID: JEMA (510)663-1100  
Chereyce Brown  
Beyer Weaver LLP  
500 12th Street, Suite 200

Oakland, CA 94607



CL58 12/07/2123

SHIP TO: (775)851-9691

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**Bally Technologies**  
**950 Sandhill Road**

**Reno, NV 89521**

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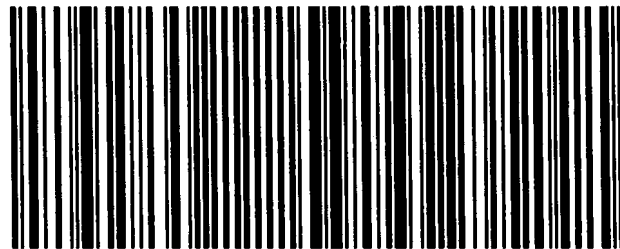
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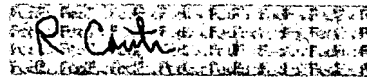
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March 16, 2007

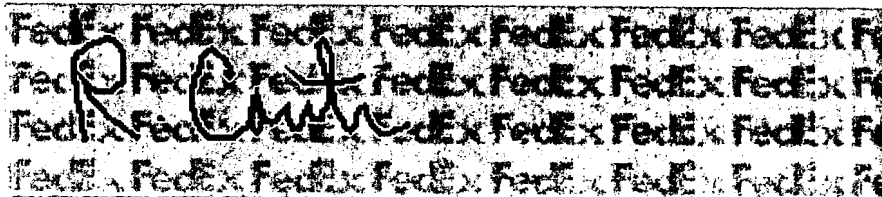
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**Recipient:**

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Bally Technologies  
950 Sandhill Road  
Reno, NV 89521 US

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## Exhibit G

April 4, 2007

KELLY G. WATSON<sup>1</sup>  
MICHAEL D. ROUNDS<sup>2</sup>  
MATTHEW D. FRANCIS<sup>3</sup>

GLORIA M. HOWRYLA<sup>1</sup>  
BRENT H. HARSH<sup>1</sup>  
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DANIELLE C. MILLER<sup>1</sup>  
CASSANDRA P. JOSEPH<sup>1</sup>  
COLT B. DODRILL<sup>1</sup>  
PADMA CHOUDRY<sup>1</sup>

OF COUNSEL-  
SIERRA PATENT GROUP

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<sup>2</sup> Also licensed in Utah

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Reply to: Reno

## VIA FACSIMILE

David P. Olynick  
Beyer Weaver  
500 12<sup>th</sup> Street, Suite 200  
Oakland, CA 94607

Re: U.S. Patent Application: Supplemental Reissue Declaration by  
Inventors for Reissue of *GAMING MACHINE HAVING SECONDARY  
DISPLAY FOR PROVIDING VIDEO CONTENT*  
Inventors: Hedrick, et al.  
Application No.: 10/817,625  
File Date: April 1, 2004

Dear Mr. Olynick:

This law firm represents Robert Luciano, as set forth in the enclosed Power of Attorney. I am in receipt of your letter dated March 12, 2007 requesting that Mr. Luciano execute a Supplemental Reissue Declaration for the 6,368,216 reissue patent application ("216 patent"). After reviewing the file histories for both the parent 6,368,216 patent and the on-going reissue patent application, Mr. Luciano respectfully declines to execute the Supplemental Declaration. In short, Mr. Luciano does not believe that all errors have been corrected, nor does he believe that IGT has acted in good faith in prosecuting the reissue application.

To begin with, Mr. Luciano has reviewed the citations made in support of the new claims and believes they do not support the "display [of] video content" on the display associated with the Player Tracking Device. Furthermore, he does not believe there is any support for stating that the secondary display recited in the claims is part of the Player Tracking Device. Accordingly, the statements made in support of the new claims appear to be at best, inaccurate, and perhaps knowingly false. Moreover, the statement that "no new matter is introduced by the above amendments" also appears to be false based upon the lack of support that is so obviously absent in the specification. See Preliminary Amendment, p. 10.



Even if there was support for the new claims in the specification – which there is not – Mr. Luciano does not believe that such claims would be enabled to allow one of ordinary skill in the art to practice the claims since there is an inadequate written description to support these claims in violation of 35 U.S.C. § 112. With no support for the claims in the specification, the enablement issues simply cannot be overcome. As such, Mr. Luciano believes that IGT has apparently made false and misleading statements to the Examiner by filing the preliminary amendment and the new claims for each of the above reasons.

There are still more issues related to the Supplemental Reissue Declaration. First, Mr. Luciano believes the above conclusions are supported not only by his reading of the file histories, but also by the Protest filed by Mr. Jeffrey L. Thompson on March 9, 2005, reaching the same conclusions regarding new matter and a lack of enablement. Further, the Examiner's Interview Statement of January 23, 2006 in response to a personal interview held with IGT's representative on January 18, 2006, also supports his conclusions. In the Interview Summary, the Examiner states that "Applicant's Representative agreed with the new matter issue." Again, a simple reading of the specification by IGT is all that was required to determine that the citations made in support of the new claims are erroneous. Nevertheless, IGT still proffered the citations in support of the new claims. Mr. Luciano is concerned that this was an intentional act to deceive the Patent Office.

Second, upon Mr. Luciano's reading of the file history for the parent '216 patent, it is clear to him that IGT obtained allowance of the original claims by arguing that the Claypole, Okada, Kennedy, and Thomas prior art references do not teach a player tracking device as claimed in the present invention. See '216 patent, Paper 5, pages 6-8. However, claim 63 (and dependent claims 64-67) of the '216 Reissue Application removes the Player Tracking Device terms. As you know, in a reissue application, the deletion of a claim element that is germane to a prior art rejection in the parent application is improper under the Recapture Doctrine. This doctrine appears to have been clearly violated. Accordingly, Mr. Luciano is again disturbed that IGT is attempting to claim subject matter that it is not entitled to.

Mr. Luciano is aware that he was previously asked to execute an Original Reissue Declaration for the pending 6,368,216 reissue patent application. See paragraph 5 of the Original Declaration. However, at the time Mr. Luciano executed the Original Declaration, he unfortunately did not specifically review the preliminary amendment IGT filed along with the Reissue Application and Original Declaration. It was Mr. Luciano's pattern and practice for several years to rely upon the representations and work product of IGT's patent attorneys for accuracy, and he did so in this instance. Had Mr. Luciano known of the contents of the preliminary





amendment, he would have certainly declined to execute the Original Declaration because there is so obviously no support in the specification for the new claims proffered in the preliminary amendment.

In view of the above, Mr. Luciano cannot in good faith, let alone subject to penalty of perjury, execute the Supplemental Reissue Declaration. He does not agree with the statement made in the Supplemental Reissue Declaration that "[e]very error in the patent was corrected...without any deceptive intent on the part of the applicant." To the contrary, it appears to Mr. Luciano that IGT mislead the Patent Office as to the new matter added by the preliminary amendment. Once confronted with the new matter rejection, and admitting to it, IGT has now attempted to recapture relinquished subject matter by improperly expanding at least claim 63 of the reissue application. Based upon Mr. Luciano's reading of the file histories, it appears clear that IGT has acted improperly before the Patent Office.

I hope the above adequately explains Mr. Luciano's position. Please contact me with any questions.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael D. Rounds".

Michael D. Rounds  
WATSON ROUNDS  
A Professional Corporation

cc: United States Patent and Trademark Office

**POWER OF ATTORNEY**

I, Robert Luciano, the undersigned, of 950 Sandhill Road, Reno, NV 89511, make, constitute and appoint Michael D. Rounds of Watson Rounds, 5371 Kietzke Lane, Reno, Nevada 89511 (Washoe County) my true and lawful attorney-in-fact, in my name, place and stead, on my behalf, and for my use and benefit:

To exercise or perform any act, power, duty, right or obligation whatsoever that I now have, or may subsequently acquire the legal right, power or capacity to exercise or perform, in connection with, arising from or relating to reissue patent application number 10/817,625.

The rights, powers, and authority of attorney-in-fact granted shall commence and be in full force and effect on April 4, 2007. Such rights, powers and authority shall remain in full force and effect unless otherwise terminated by me.

IN WITNESS WHEREOF the party below has executed this Power of Attorney as of the date set forth below,

By: 

Robert Luciano

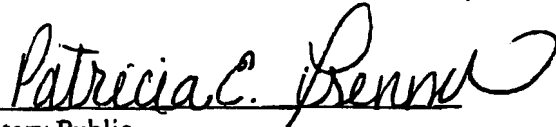
Date: 4-04-07

STATE OF NEVADA )

) ss:

COUNTY OF WASHOE )

This instrument was acknowledged before me on April 4,, 2007, by

Robert Luciano  
Notary PublicMy Commission Expires: 11/21/2010